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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,300	10/12/2001	Dan Canaani	P-4393-US1	8148

27130 7590 09/10/2003
EITAN, PEARL, LATZER & COHEN ZEDEK LLP
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NEW YORK, NY 10020

EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 09/10/2003 //

Please find below and/or attached an Office communication concerning this application or proceeding.

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TECH CENTER 1600/2900

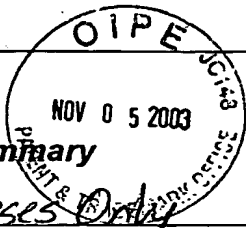
ATTORNEY: IG

ACTION: D-OA DUE 10-Oct-03

ACTION: ROADEAD DUE 10-Feb-03

ACTION: OADEAD DUE 10-Mar-03

DOCKETED BY: MC DATE 25 Sep 03



Office Action Summary

Restriction Purposes Only

Application No.

09/975,300

Applicant(s)

CANAANI ET AL.

Examiner

Padmashri Ponnaluri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-88 are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, 84-85, drawn to a method of screening molecule which have a synthetic lethal property when in combination with a gene of interest and a kit, classified in class 435, subclass 6.

(NOTE claims 10-12 missing).

II. Claims 13-15, 18-25 and 86, drawn to a method of screening a cDNA molecule and a kit, classified in class 435, subclass 6.

(NOTE claims 16-17, 26-27 missing).

III. Claims 28-36, drawn to a method of screening a drug which have a synthetic lethal property when in combination with a gene of interest, classified in class 435, subclass 7.1.

IV. Claim 37-45, drawn to a method of screening a library comprising plurality of molecules which have a synthetic lethal property, classified in class 435, subclass 7.1.

V. Claims 46-54 and 84-85, drawn to a method for screening molecule which have a synthetic lethal property when in combination with a mutant or normal gene of interest which is overexpressed, classified in class 435, subclass 6.

VI. Claims 55-65 and 86, drawn to a method of screening a cDNA molecule, classified in class 435, subclass 6.

VII. Claims 66-74, drawn to a method of screening a drug which have a synthetic lethal property, classified in class 435, subclass 6.

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- VIII. Claims 75-83, drawn to a method for screening a library, classified in class 435, subclass 7.1.
- IX. Claim 87, drawn to a survival plasmid comprising a functional gene of interest, classified in class 4.5, subclass 235.1.
- X. Claim 88, drawn to a survival plasmid comprising a dominant-negative mutant gene of interest, classified in class 435, subclass 235.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of groups I-VIII are drawn to different methods which are distinct from each other by different method steps and the results of the different methods is different. The different methods are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Thus restriction between the groups is proper.

3. Inventions of groups IX -X (Products) and groups I-VIII (methods of the use of the product) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the different methods use the products of groups IX and X, thus restriction between the groups is proper.

4. Inventions of groups IX and X are drawn to different and distinct products. The different products of groups IX and X are not disclosed as capable of use together and they have

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different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Thus restriction between the groups is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Even though some of the groups are classified in the same class/subclass, this has no effect on the non-patent literature search. Different inventions or groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive. Therefore, these do not create an undue search burden, and restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: If either group is elected applicants are requested to elect a single species for each of the following:

- a) a single species of (screening)molecule;
- b) a single species of gene of interest;
- c) a single species of first reporter gene;
- d) a single species of second reporter gene;
- e) a single species of selectable marker;
- f) a single species of selection compound;
- g) a single species of cells;
- h) a single species of vector vehicle;
- i) a single species of drug;
- j) a single species of survival plasmid;
- k) a single mutant gene of interest;

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- 1) a single gene of interest which is overexpressed.

The species election is proper because the different species of each of the above would lead into a different results (or product) or have a different effect on the method claims.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Padmashri Ponnaluri
Primary Examiner
Art Unit 1639

PP
08 September 2003

~~PADMASHRI
PRIMARY~~


PADMASHRI PONNALURI
PRIMARY EXAMINER